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In re Application of	:
HUTCHINSON, Daniel Mark et al.	: DECISION ON
US Application No.: 10/031,059	:
PCT Application No.: PCT/US00/19115	: PETITION
Int. Filing Date: 13 July 2000	:
Priority Date: 16 July 1999	: UNDER
Attorney's File Reference: RCA 89694	:
For: METHOD AND APPARATUS FOR	: 37 CFR 1.47(a)
PROVIDING DUAL AUTOMATIC GAIN	:
CONTROL DELAY SETTINGS IN A	:
TELEVISION RECEIVER	:

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(b) ONE INVENTOR NOT AVAILABLE", filed 28 May 2002, which is being treated as a petition under 37 CFR 1.47(a) requesting acceptance of the application without the signature of co-inventor Ricardo Haro (Haro). The \$130.00 petition fee has been paid.

BACKGROUND

On 13 July 2000, applicants filed international application number PCT/US00/19115, which claimed priority to a prior US application filed on 15 July 1999. A demand for international preliminary examination was filed on 14 February 2001. Accordingly, the thirty-month period for paying the basic national fee in the United States of America expired at midnight on 15 January 2002.

On 15 January 2002, applicants filed a transmittal letter for entry into the national stage in the United States of America under 35 USC 371, which was accompanied by, inter alia, the basic national fee. No oath or declaration of the inventors was included.

On 01 April 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements which indicated, inter alia, that an oath or declaration of inventorship and a surcharge under 37 CFR 1.492(e) for providing a late

oath or declaration must be furnished by 2 months from the mailing date of the notification but that extensions of time were available under 37 CFR 1.136(a).

On 28 May 2002, the applicants filed, inter alia, the following papers:

1) a petition under 37 CFR 1.47(a) stating the last known address of nonsigning co-inventor Haro and the required \$130.00 petition fee;

2) a declaration and power of attorney naming co-inventors Daniel Mark Hutchinson (Hutchinson), Gary Dean Grubbs (Grubbs), Matthew Thomas Mayer (Mayer), and Haro but including only the signatures of Hutchinson, Grubbs, and Mayer;

3) a copy of a letter from Davida Fornarotto (Fornarotto) to Haro, dated 20 December 2001, indicating, inter alia, that she was enclosing a declaration for the above-identified US national stage application along with a copy of the above-identified international application as filed and requesting, inter alia, that he sign and return the declaration to her before 07 January 2002;

4) copies of Federal Express receipts indicating that correspondence was sent from Fornarotto to Haro on 20 December 2001 and delivered to Haro on 21 December 2001;

5) a declaration, signed by Fornarotto and dated 28 May 2002, indicating, inter alia, that a declaration of inventorship for signature in the above-identified US national stage application, was sent to Haro on 20 December 2001 but that, as of the date of this petition, she had still not received a response from Haro;

6) a \$130.00 surcharge for a late declaration under 37 CFR 1.492(e).

DISCUSSION

37 CFR 1.47(a) states:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

Further, MPEP section 409.03(d) under the heading "Inventor Cannot be Reached" states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted

that fully describes the exact facts which are relied on to establish that a diligent effort was made.

* * * * *

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

The petition indicates that, on 24 January 2002, Jack Schwartz (Schwartz) attempted to contact Haro at his last telephone number. Applicants must provide a statement, signed by Schwartz, detailing his attempt to contact Haro.

With regard to the declaration of inventorship, the indication of the fourth named inventor Haro is crossed through in pencil. Accordingly, there is some question as to whether co-applicants Hutchinson, Grubbs, and Mayer understood that Haro was being named as a co-inventor when they signed the declaration. Applicants should provide a new declaration clearly naming all four co-inventors.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response to this decision will result in ABANDONMENT of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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